

REMARKS/ARGUMENTS

In response to the Office Action dated June 27, 2005, claim 1 is amended. Claims 1-18 are now active in this application. No new matter has been added.

OBJECTION TO THE TITLE

The Examiner continues to object to the title even though it has been amended by Applicants. Since the title is descriptive of the invention claimed, it complies with the M.P.E.P.. However, if the Examiner is not satisfied with the title, he is invited to change the title to that which he considers more appropriate at the time the application is allowed (see M.P.E.P. § 606.01).

REJECTION OF CLAIM 1 UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claim 1 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In support of this position with regard to claim 1, the Examiner identifies a phrase that is deemed confusing. By this response, the noted point of indefiniteness of claim 1 has been appropriately addressed. Specifically, the confusing and/or vague language is deleted in favor of language believed to recite the invention with the degree of precision and particularity required by the statute. In particular, claim 1 recites, *inter alia*:

wherein, in a case where the first mode is set, said controller controls said translating means so as to translate the document data into a plurality of languages different from one another and different from an original language of the document data, and controls said output unit so as to output the translated document data by language groups, the language of each language group being one of the plurality of languages...

REJECTION OF CLAIMS UNDER 35 U.S.C. §112, FIRST AND SECOND PARAGRAPHS

Claims 6 and 10 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In support of this position with regard to claim 6, the Examiner asserts that “the limitations ‘document data’ lacks clearly defined scope for the claims. Since the limitation can be interpreted in many different ways, ... its different interpretations may direct the claim to structurally incompatible embodiments and/or cause an enablement problem... No specific objection is made with respect to claim 10.

Claims 1-18 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Examiner maintains that “the limitations ‘document data’ includes text, video, audio and speed data, which has much broader scope than only text (or textual) document data that the application is processed for translation. In terms of translation for other type of data, such as speech or audio, there is no disclosure in the specification, therefore, the specification does not enable any person skilled in the art to make and/or use the invention commensurate in scope with the claims.”

The rejection is respectfully traversed.

Case law precedent has established that an analysis under 35 U.S.C. § 112 begins with a determination of whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. Claim language is viewed not in a vacuum, but in light of the teachings of the prior art and of the application disclosure as it would be interpreted by one possessing the ordinary level of skill in the art. *In re Johnson*, 558 F.2d

1008, 194 USPQ 187 (CCPA 1977); *In re Moore*, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971).

A decision on whether a claim is invalid under this section of the statute requires a determination of whether those skilled in the art would understand what is claimed when the claim is read in light of the specification, *Seattle Box Co. v Industrial Crating & Packing*, 731 F.2d 381, 385, 221 USPQ 568, 574 (Fed. Cir. 1984).

In determining definiteness, no claim may be read apart from and independent from the disclosure on which it is based. *In re Cohn*, 169 USPQ 95, 98 (CCPA 1971); *In re Kroekel*, 183 USPQ 610, 612 (CCPA 1974):

... claims are not to be considered in a vacuum, "but always in light of the teachings of the prior art and the particular application disclosure as it would be viewed by one possessing the ordinary level of skill in the pertinent art." When considered in light of the prior art and the specification, claims otherwise indefinite may be found reasonably definite.

The Examiner's criticism of the claims is clearly directed to breadth of scope and not indefiniteness. The phrase 'document data' is found at many locations of the specification; e.g., page 9, lines 21 and 26-27, page 10, lines 9 and 23. Thus, support for reciting 'document data' is found in the specification. Thus, claims 1-18 are described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The present rejections improperly attempt to limit the scope of the claims by requiring additional limitations under the guise that such limitations are necessary to make the claims definite.

It is submitted that when the claim language 'document data' is read in light of the specification, an artisan would readily understand the metes and bounds of the invention. The fact that a claim is broad does not justify a rejection on the ground that the claim is indefinite or

incomplete (see § 706.03(d) of the M.P.E.P.) or that the claim does not reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Therefore, claims 1-18 are definite and it is respectfully urged that the rejections be withdrawn.

It should be noted also that the disclosure need not recite the claim language in *haec verba*. *In re Smith*, 481 F.2d 910, 178 USPQ 620 (CCPA 1973).

Claim 6 is further rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In this regard, the Examiner maintains that “in a case where the prescribed mode is set, said controller controls said translating means so as *to translate the document data including a plurality of different languages into at least one language*... lacks detail description in the specification to support the claimed invention”. The Examiner further asserts that “It is noted that the closet disclosure (see specification page 19, lines 2-3 and Fig. 16) does not specifically describe what kind of document data (source data) is (such as sentences, paragraphs, pages, or separate documents, is mixed languages) and how to access and/or process the document data...”

The rejections is respectfully traversed.

The Examiner clearly has not properly review the current specification as the corresponding description for the noted language is found at page 10, line 21 to page 11, line 22 with reference to Figs. 4 and 5. As can be seen in Figs. 4 and 5, the (original) document data includes different languages A, B and C and the original document data is translated, in Fig. 4, into language A, while in Fig. 5, the original document data is translated into plural languages A, B and C.

Given that the specification does describe the subject matter of claim 6 in such a way as to enable one skilled in the art to which it pertains ... to make and/r use the invention, withdrawal of the rejection of claim 6 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement, is respectfully solicited.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 103

Claims 1, 2, 4-18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Yamauchi et al. (USPN 5,701,497) in view of Flores et al. (USPN 6,370,498) for the reasons of record..

Claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over Yamauchi et al. in view of Flores et al., and further in view of Miyahara et al. (USPN 6,314,213).

The rejections are respectfully traversed.

Independent claim 1 requires that:

in a case where the second mode is set, said controller controls said translating means so as to translate the document data into a plurality of languages, each different from the original language of the document data, and ***controls said output unit so as to output the translated document data by groups***, each group including the translated language document data translated in each of the plurality of languages. (Emphasis added)

Independent claim 14 requires that:

said controller controls said translating means so as to translate the document data in an original language into a first language and a second language, each being different from the original language, and ***controls said output unit so as to output the document data translated into the first and second languages as a common group***, said controller further controls said output unit to repeatedly output the common group by the number set by said operation unit. (Emphasis added)

As noted in the previous response, Yamauchi et al. discloses that a received document written in a first language is translated into a second language, different from the first language, and then outputted. Yamauchi et al. discloses also that at the time of outputting, documents are simultaneously printed in the first language and second language. That is, the document to be translated and the translated document are simultaneously outputted. Furthermore, Yamauchi et al. intends to output only two documents, i.e., the document to be translated and the translated document. Accordingly, in the example of the simultaneous outputting, the document to be translated and the translated document are printed on the front side and back side of the paper, respectively (see column 4, lines 53-60, column 20 lines 32-column 21 line 28, Figs. 24 and 25).

However, Yamauchi et al. never discloses or suggests that translating a document into a plurality of languages and then outputting the translated documents by groups where each group includes the translated document translated in each of the plurality of languages. Such groups can be seen in Fig. 2 of the present application where Group I is the documents translated into language A, Group II is the documents translated into language B and Group III is the documents translated into language C.

As noted further in the previous response, if it is assumed that Flores et al. teaches that a language is translated into a plurality of languages, and such teaching were applied to Yamauchi et al., the following structure will result:

In the case where the teaching of Flores et al. that a document to be translated (hereinafter referred to as “original document”) is translated into different languages (e.g., “first translated document” and “second translated document”) is applied to the device disclosed in Yamauchi et al., since Yamauchi et al. discloses that an original document and a translated document are simultaneously outputted as mentioned above (the document to be translated and

the translated document are printed on the front side and back side of the paper), a structure would result in which the original document and the first translated document are simultaneously outputted and that the original document and the second translated document will be simultaneously outputted.

To expedite prosecution, claim 1 is further amended to delineate:

wherein, in a case where the second mode is set, said controller controls said translating means so as to translate the document data into a plurality of languages different from one another and different from the original language of the document data, and controls said output unit so as to output the translated document data by groups, each group of the translated document data comprising the original language and the translated document data translated in each of the plurality of languages.

Thus, even if the original document and the first translated document are a first group, and the original document and the second translated document is a second group, each group would not consist of a common language that is one of the plurality of languages. In addition, there would not be a groups of translated documents comprising the first and second languages (claim14).

Regarding independent claims 6, 11 and 17, they are directed to a unification mode (Figs. 4 and 5) in the embodiment in which a document to be translated includes a plurality of languages which will be translated into at least one language and the translated document is outputted. Neither Yamauchi et al. nor Flores et al. discloses or suggests that *a document including a plurality of languages is translated into at least one language and then the translated document is outputted.*

It is, therefore, respectfully submitted that the Examiner did not establish a *prima facie* basis to deny patentability of the claimed invention under 35 U.S.C. § 103 for want of the requisite factual basis. Specifically, the Examiner has failed to identify a source in the applied

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prior art references for every claim limitation. Accordingly, withdrawal of the Examiner's rejection of claims 1-18 under 35 U.S.C. § 103 is respectfully solicited.

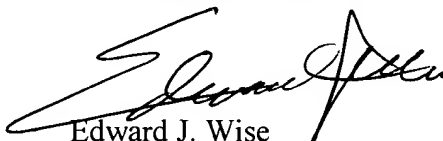
CONCLUSION

Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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